

REMARKS

In response to the Office Action mailed October 3, 2003 and the Advisory Action mailed October 31, 2003, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to place the present application in condition for immediate allowance, claims 2-5, 7-10, 12-20, 24-26, 28, 30-31, and 34-46 have been canceled. *No claim amendments are presented in this response, accordingly none of the claims pending in this case require new consideration or any further search.*

Election/Restrictions

In response to the requirement to elect a single disclosed species for prosecution, applicant elects a single species as provided in claims 1, 5, 10, 21-32, 35-41, and 44. In view of this election, applicant has canceled without prejudice, the withdrawn claims 2-4, 7-9, 12-20, 34, 42-43, and 45-46.

Rejections Under 35 USC §102(b)

Claims 21-23, 29 and 32 have been rejected under 35 USC §102(b), as being anticipated by *Yonkers (US 3,985,383)*.

Claim 21: Claim 21 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 21 as previously amended specifies amongst other things, as follows:

"21. A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface with a non-slip texture;

said pad being sufficiently flexible to conform to a contoured surface area of a body part;

said pad having its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area; and said pad having its lower surface provided with indicia to decorate said contoured surface area."

Nowhere is this combination of elements and steps described in, nor suggested by the *Yonkers reference*

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

In the present Office Action, the Examiner's rejection is based on the *Yonkers reference*, which fails to show all of the essential elements of the instant invention.

The *Yonkers reference* describes an indexing or separating device not a fashion wear item that is embodied within a novelty kit. More specifically the *Yonkers reference* describes a layer of plastic film 14 that has an upper surface 19 and a bottom surface 15, where the bottom surface 15 is coated with a pressure sensitive adhesive material 16 that enables the layer of plastic film 14 to be attached to the finger 11 of a user. The *Yonkers reference* further discloses that the layer of plastic film 14 is flexible so as to conform easily to the contour of the finger 11, or in the alternatively, it is rigid to serve not only as a support element but also as protection against punctures caused by the objects being indexed or separated. With reference to the *Yonkers reference* teaching that the layer of plastic film 14 is a support element, the *Yonkers reference* further provides that the upper surface 19 is coated with a layer of cement that secures a mass of traction material 18 to the upper surface, where the mass of traction material 18 has a very high coefficient of friction with respect to the objects to be indexed and is composed of an elastomeric

material such as foam and sponge rubber containing glycerine; or in an alternative embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched to increase its traction capability or rubber threads which have been released from a liquid rubber container onto the plastic layer of film 14.

Turning now to the comments of the examiner relative to what is taught by the *Yonkers reference*:

1. Yonkers provides ...The pad having its lower surface provided with indicia to decorate the contoured surface area (column 4, lines 10-19). Column 4, lines 10-19 merely provide that "the indexing device 10 includes variations of color and shape (FIG. 6) of both the mass of traction material 18 and the layer of plastic film 14. For example, the device 10 may be formed in the shape of a heart 22, a square, a clover 26 or a diamond 28." In this case, there is no teaching or disclosure that the lower surface of the device 10 is "provided with indicia to decorate said contoured surface areas." Instead the *Yonkers reference* is teaching that the elements of the device 10: the layer of plastic material 14, and the mass of traction material 18 can have a color or can be shaped to a desired configuration. There is nothing however, to suggest that indicia in the form of advertisement or text is disposed on the lower surface; instead the *Yonkers reference* teaches away from this since the lower surface of the layer of plastic film 14 is coated with a cement to secure the mass of traction material 18 to its support element, the layer of plastic film 14.

2. That Yonkers provides.... the non skid pad has sufficient thickness to protect the contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface (column 3, lines 14-29). Column 3, lines 14-19 provides:

"In accordance with a further important feature of the present invention, a mass of traction material 18 having a very high coefficient of friction with respect to the objects to be indexed is disposed on a second side or surface 19 of the film 14. The mass of traction material 18 may be of the same general configuration as the layer of plastic film 14 and may be attached thereto by cement. The mass of traction material 18 may, in a specific embodiment, be an elastomeric material such as foam and sponge rubber containing glycerine; or in an alternate embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched (FIG. 3) to increase its traction

capability. The mass of traction material 18 may alternately comprise rubber threads which are released from a liquid rubber container onto the plastic layer of film 14."

There is nothing in this cited text that would suggest that thickness has been considered to protect the finger of a user when brought into engagement with the ground. This is obvious, since the *Yonkers reference* only discusses rigidity as a means for protecting the finger and moreover, the device 10 is not something that engages the ground for indexing purposes, but instead is an indexing device for separating adjacent planar objects, such as stacked sheets of paper. (See Column 2, lines 52-54). In this regard, there is nothing in the cited text that would suggest that the layer of plastic film 14 is a pad with a non slip texture.

3. The Yonkers reference provides.... The flexible pad conforms to the user's fingers and is made out of foam and sponge rubber (Column 2, lines 14-50). As quoted above, only the mass of traction material 18 is described as being composed of foam and sponge rubber. The "pad" as utilized in the context of the cited reference refers to the layer of plastic film 14. Therefore there is no teaching or suggestion in the *Yonkers reference* that the layer of plastic film 14 is made out of foam and sponge rubber.

4. That Yonkers provides.... The non-skid pad of Yonkers is capable of being trimmed and disposed of after use. Yonkers would seem to teach away from trimming the device 10 since the *Yonkers reference* teaches that "it is believed that the excellent adhesion of the layer of plastic film 14 to the finger 11 results from the extension of the outer periphery of the layer of plastic film 14 beyond the outer periphery of the mass of traction material 18, that is, the mass of traction material 18 has a smaller cross sectional area than the cross-sectional area of the layer of plastic film 14. Therefore if a user would trim the device to fit the finger of a small person, it could well result in a disruption of the desired cross-sectional relationship between the film 14 and the mass of traction material 18.

5. That Yonkers provides.... a method of providing a decorative pad with a non slip texture to the finger of a user (Column 1, lines 66-68 through column 2, lines 1-2.)

The cited text provides:

An additional object of the present invention is to provide a new and improved device for indexing or separating adjacent planar objects that is attractive in appearance and does not readily produce skin irritation."

There is nothing in this cited text to suggest that the film material 14 includes decorative indicia or that the film material 14 has a non slip texture.

Specific Claim Rejections

Claim 21: Considering now the specific rejection of claim 21 in greater detail, the novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not disclose, nor suggest "a flexible pad having an upper surface and a lower surface with a non-slip texture..." Instead the *Yonkers reference* teaches a flexible layer of plastic film 14 that serves as a support element for the mass of traction material 18, which material 18 has a very high coefficient of friction to facilitate separating adjacent planar objects, such as sheets of paper as illustrated in FIG. 2. In this regard, it is the mass of traction material 18 that has the non slip texture, not the layer of plastic film 14.

Secondly, the *Yonkers reference* does not teach, nor suggest, "removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area." Instead the *Yonkers reference* teaches that a layer of plastic film 14 is attached to the finger of a user wishing to index or separate adjacent planar objects 12, such as sheets of paper as illustrated in FIG. 2. (Col 2, lines 51-54). Moreover, the *Yonkers reference* teaches that the layer of plastic film 14 is a support element for the mass of traction material 18. In short, the plastic film 14 is not a platform for decorative indicia.

Finally, the novel features and steps of the present invention are not suggested, nor taught by the *Yonkers reference* in that the *Yonkers reference* does not suggest, nor teach "said pad having its lower surface provided with indicia to decorate said contoured

surface area." Instead, the *Yonkers reference* teaches the other surface of the film 14 is coated with a layer of cement (Col 3, lines 18-21) that secures to that surface the mass of traction material 18.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 21 as previously amended patentably distinguishes over the *Yonkers reference*.

Claim 22: Claim 22 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 22 as previously amended specifies amongst other things, as follows:

"22. A method of decorating a body part, comprising the steps of:
 providing decorative fashion wear;
 said fashion wear including:
 a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;
 providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;
 providing the lower surface with indicia to decorate the contoured surface area of the body part; and
 applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes."

The novel steps of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not disclose, nor suggest "providing decorative fashion wear..." Instead, the *Yonkers reference* teaches an indexing device 10 not fashion wear.

Secondly, the *Yonkers reference* does not teach nor disclose "a flexible pad with a non-slip texture". Instead the *Yonkers reference* teaches a layer of plastic film 14 having affixed to one of its surfaces "a mass of traction material 18". In short, there is

nothing to suggest that the layer of plastic 14 has a non slip texture; instead it is the mass of traction material 18 that has the non-slip texture.

Thirdly, the *Yonkers reference* does not suggest nor disclose, "said pad having its lower surface provided with indicia to decorate said contoured surface area." Instead, the *Yonkers reference* teaches that both its upper and lower surfaces are coated with an adhesive material and that the device 10 is for indexing or separating adjacent planar objects not for decorating purposes.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 22 as previously amended patentably distinguishes the *Yonkers reference*.

Claim 23 Claim 23 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 23 as originally filed specifies amongst other things, as follows:

"23. A fashion wear item, comprising:
a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces....."

The novel steps of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not teach nor disclose, "a non-slip pad..." Instead the *Yonkers reference* teaches a layer of plastic film 14 that function as a support element for a mass of traction material 18 that is affixed by cement to one of its surfaces.

Finally, the *Yonkers reference* does not suggest nor disclose "a non slip pad having ...decorative indicia covering at least a portion of another one of its surfaces..." Instead, the *Yonkers reference* teaches a layer of plastic film 14 having both of its surfaces coated with an adhesive material.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 23 as previously amended patentably distinguishes over the *Yonkers reference*.

Claim 27: Claim 27 depends from claim 23 as previously amended and accordingly patentably distinguishes over the *Yonkers reference* under the same rationale as claim 23. Therefore, claim 27 as originally filed patentably distinguishes over the *Yonkers reference*.

Claim 29: Claim 29 as originally filed patentable distinguishes over the *Yonkers reference*. In this regard, claim 29 as originally filed specifies amongst other things, as follows:

"29. The fashion wear item according to claim 23, wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbows of a user to provide decoration for the body part selected."

Claim 29 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, there is nothing in the *Yonkers reference* that would indicate that the indexing device 10 would be suitable for use with other body parts selected from the hands, feet, toes, knees and elbows of a user.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 29 as originally filed patentably distinguishes over the *Yonkers reference* under the same rationale as set forth earlier relative to claim 23 and as well as for the reasons given herein.

Claim 32: Claim 32 as originally filed patentable distinguishes over the *Yonkers reference*. In this regard, claim 32 as originally filed specifies amongst other things, as follows:

"32. The fashion wear item according to claim 23, wherein the decorative indicia is selected from an indicia group consisting of color, patterns, messages, trademarks, and advertisements."

Claim 32 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, there is nothing in the *Yonkers reference* that would suggest that decorative indicia covers at least a portion of one of the surfaces of the layer of plastic film 14. More specifically, the *Yonkers reference* teaches that both surfaces of the plastic film 14 are covered with an adhesive material. One surface is covered with an adhesive material to enable the plastic film 14 to be attached to the finger of a user, and the other surface is coated with a cement material to enable the mass of traction material to be attached to the other surface. Therefore the *Yonkers reference* teaches away from decorative indicia covering at least a portion of another one of its surfaces, "wherein the decorative indicia is selected from an indicia group consisting of ...messages... and advertisements."

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 32 as originally filed patentably distinguishes over the *Yonkers reference*.

Rejections Under 35 USC §103

Claim 27: Claim 27 has been rejected under 35 USC §103 as being unpatentable over *Yonkers* in view of *Lee* (US 6,613,382).

Claim 27 as originally filed patentably distinguishes over the *Yonkers reference* *in view of Lee* (US 6,613,382). In this regard, claim 27 as originally filed specifies amongst other things, as follows:

"27. The fashion wear item according to claim 23, wherein the decorative indicia is screen printed on said non-skid pad.

The *Lee reference* discloses a method of manufacturing a plurality of note posters from a planar vinyl sheet having a printed surface and an opposing adhesive surface provides for first printing a plurality of images upon the printed surface.

The novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference in view of Lee* in that the cited references either alone or in combination fail to disclose or teach, "wherein the decorative indicia is screen printed on said non-skid pad." More particularly, the *Yonkers reference* teaches that the subject surface is coated with a cement to secure the mass traction material 18 to the surface of the layer of plastic 14. Therefore the *Yonkers reference* teaches away from printing on the surface of the plastic material 14 that is attached to the mass traction material 18. Accordingly, claim 27 as originally filed patentably distinguishes over the cited references for the reasons given as well as under the same rationale as set forth above with reference to claim 23.

General Comment Relative to Advisory Action of October 31, 2003

Attorney for Applicant has duly noted that the Supervisory Patent Examiner refused to enter the previous amendment filed on October 10, 2003, because the claim amendments require new consideration and search. However, many of the pending claims in the previous Amendment of October 10, 2003, were not amended in that response but had been amended previously (and entered for the purpose of the Office Action mailed on October 3, 2003) and specific arguments were presented in the October 10, 2003 response to distinguish these claims over the cited references. Notwithstanding this fact, the Supervisory Patent Examiner failed to address these claims in the Advisory Action of October 31, 2003. Attorney for Applicant is bringing this oversight to the attention of the Supervisory Patent Examiner and Examiner Hoey to make certain that no further errors are made relative to claims 21-23, 27, 29 and 32, which claims in their present form were entered for examination purposes on October 3, 2003 as noted in paragraph 2 of that Office Action.

Conclusion

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

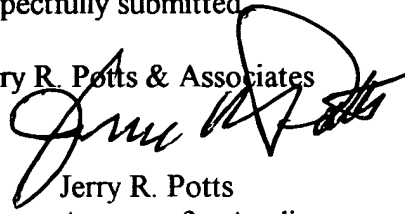
Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: November 8, 2003

respectfully submitted,

Jerry R. Potts & Associates

By

A handwritten signature in black ink, appearing to read "Jerry R. Potts", is written over the printed name and firm name.

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